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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,955

01/09/2006

Thomas E. Rajewski

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26645

7590

02/09/2011

The Lubrizol Corporation  
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EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

02/09/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,955	<b>Applicant(s)</b> RAJEWSKI ET AL.	
	<b>Examiner</b> JAMES GOLOBOY	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2010 and 15 December 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7,10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5, 7, 10, 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's affidavit filed 12/15/10 has been considered. A new ground of rejection has been set forth below in light of the affidavit.

#### ***Claim Rejections - 35 USC § 103***

2. Claims 1-2, 5, 7, 10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko in view of Takashima (JP 11-335684)

In column 1 lines 8-22 Kaneko discloses a refrigerating oil composition, and in column 1 lines 24-28 and the examples teaches that the composition is used in a gas compressor, as recited in claims 1 and 13. In column 1 lines 8-15 Kaneko teaches that the composition can be used in conjunction with hydrofluorocarbon or ammonia coolants, meeting the limitations of claims 2, 7, and 14. In column 24 lines 24-26 Kaneko teaches that the base oil can be a polyalphaolefin or alkylbenzene, meeting the limitations of claims 5 and 10. Kaneko does not disclose the inclusion of the claimed polymer in the composition.

A machine translation of Takashima, which is attached, has been used in setting forth this rejection. In paragraph 7 Takashima discloses a lubricating oil composition for gas compressors comprising a viscosity index improver. In paragraphs 42-61 Takashima discusses the viscosity index improver, which is a copolymer of a first monomer (paragraphs 42-45) and a second nitrogen-containing monomer. In paragraphs 44 and 51-52 Takashima discloses a first monomer (formula 6), which can be a C2 to C8 branched olefin. In paragraph 60 Takashima discloses that the mole

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percent of the first monomer is generally between 80 and 95%, within the range recited in claims 1 and 13, and in paragraph 61 discloses that the average molecular weight ranges from 1,000 to 300,000, overlapping the range recited in claims 1 and 13. IN Table 1 (paragraph 90) Kaneko discloses compositions comprising 0.1 or 0.2% by weight of the additive, within the ranges recited in claims 1 and 13. The inclusion of the viscosity index improver of Takashima in the gas compressor lubricant composition of Kaneko therefore meets the limitations of claims 1-2, 5, 7, 10, and 12-14.

It would have been obvious to one of ordinary skill in the art to include the dispersant-viscosity index improver copolymer of Takashima in the composition of Kaneko, as Takashima discloses that it is a useful additive for gas compressor lubricants.

### ***Response to Arguments***

3. Applicant has submitted a declaration dated 11/23/10 and signed by Lilje, arguing that viscosity index improvers are not added to gas compressor oils and one of ordinary skill in the art would not have been motivated to combine Kaneko and Yagishita. In response to this argument, a new ground of rejection over Kaneko and Takashima has been set forth above. Takashima explicitly discloses a gas compressor composition comprising a dispersant-viscosity index copolymer meeting the limitations of the claimed additive.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES GOLOBOY whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Goloboy/  
Examiner, Art Unit 1771